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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,031	10/03/2000	Masaki Kyojima	107500	5676

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EXAMINER
LE, DAVID Q

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	**Application No.** 09/678,031	**Applicant(s)** KYOJIMA ET AL.
	Examiner David Q Le	**Art Unit** 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-34* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-34* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

     If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☒ All b)☐ Some * c)☐ None of:

       1.☒ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____ .

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

     a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) ☐ Other: .

DETAILED ACTION

Examiner's Note

1.   Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   **Claims 1-34** are rejected under 35 U.S.C. 102(b) as being anticipated by ***Ginter et al.***, US Patent No 5,892,900.

As per **claims 1, 2**:
Ginter discloses a
license-issuing [method and system] *for issuing an electronic license for certifying that usage of digital contents is permitted to a specific user, the method comprising:*
    generating information for verification required to verify legitimacy of an electronic license;
    inputting information to specify the information for verification; generating the electronic license which can be verified by the information for verification specified by the input information to specify the information for verification; and
    outputting the generated electronic license (Abstract; Figs 1, 2, 2A, 5A-B, 14B, 77-78, associated text; Cols 3-6: "Chain of Handling and Control"; Col 10, line 47- Col 11, line 21; Col 55, line 61 - Col 59, line 6; Col 206-212; Col 220-224).

As per **claims 9, 10**:
Ginter discloses a
license intermediation [method and system] *for intermediating a request for an electronic license for certifying that usage of digital contents is permitted to a specific user, the method comprising:*
    receiving a first license request which is a request for issuance of the electronic license for certifying that the usage of specific digital contents is permitted;
    preparing a second license request for requesting the issuance of the electronic license requested in the received first license request; and outputting the prepared second license request (Abstract; Figs 1, 2, 2A, 5A-B, 14B, 77-78, associated text; Cols 3-6: "Chain of Handling and Control"; Col 10, line 47- Col 11, line 21; Col 55, line 61 - Col 59, line 6; Col 206-212; Col 220-224).

As per **claims 16, 17**:
Ginter discloses an
agreement issuing [method and system] *for allowing intermediation of a request for an electronic license for certifying that usage of digital contents is permitted to a specific user, the method comprising:*
inputting information to specify an intermediator who intermediates a request for an electronic license for digital contents;
inputting information to specify the digital contents the intermediation of which is permitted to the intermediator;
generating an agreement for certifying that the intermediation of the request for the electronic license for the specified digital contents is permitted to the specified intermediator; and
outputting the generated agreement (Abstract; Figs 1, 2, 2A, 5A-B, 14B, 77-78, associated text; Cols 3-6: "Chain of Handling and Control"; Col 10, line 47- Col 11, line 21; Col 55, line 61 - Col 59, line 6; Col 206-212; Col 220-224; Col 269-270 "Negotiation of Contracts").

As per **claims 20, 24**:
Ginter discloses (see above citations; Cols 189 – 206: "Examples of VDE Methods")
a feature providing [method and system] *for providing a user one or more features, comprising:*
storing information for verification to verify an electronic license for certifying that usage of all or part of features is permitted to a specific user;
inputting an electronic license;
verifying legitimacy of the input electronic license using the stored information for verification; and
activating at least part of the features only in the case it is judged that the input electronic license is legitimate.

As per **claims 21, 25**:
Ginter discloses (see above citations; Cols 189 – 206: "Examples of VDE Methods")
a digital contents operation [method and system], *comprising:*
storing information for verification to verify an electronic license for certifying that operation of digital contents is permitted to a specific user;
inputting an electronic license;
verifying legitimacy of the input electronic license using the stored information for verification; and
enabling at least part of operations of the digital contents only in the case it is judged that the input electronic license is legitimate.

As per **claims 22, 27**:
Ginter discloses (see above citations; Cols 189 – 206: "Examples of VDE Methods")
a digital contents decrypting [method and system] *for decrypting encrypted digital contents, comprising:*
storing information for verification to verify an electronic license
that certifies that decrypting of encrypted digital contents is permitted to a specific user;
inputting an electronic license;
verifying legitimacy of the input electronic license using the stored information for verification; and

decrypting the encrypted digital contents only in the case it is judged that the input electronic license is legitimate.

As per **claims 23, 29**:

Ginter discloses (see above citations; Cols 189 – 206: "Examples of VDE Methods")

a digital contents decompression [method and system] *for decompressing compressed digital contents, comprising:*

a step for storing information for verification to verify an electronic license that certifies that the decompression of compressed digital contents is permitted to a specific user;

a step for inputting an electronic license;

a step for verifying the legitimacy of the input electronic license using the stored information for verification; and

a step for decompressing the compressed digital contents only in the case it is judged that the input electronic license is legitimate.

As per **claim 3**:

Ginter discloses all the limitations of claim 2.

Ginter further discloses that fine-grained control of usage conditions may be effected by his invention (see all above citations). Therefore Ginter meet all the limitations of claim 3, namely:

...usage condition generation means for generating a usage condition which is a condition for limiting usage of digital contents, wherein:

the usage condition generated by the usage condition generation means is included in the electronic license generated by the license generation means.

As per **claim 4**:

Ginter discloses all the limitations of claim 2.

Ginter further discloses that multi-tiered distribution may be set up for the controlled distribution of digital property, with content and rules created at each level, participant of the network (see above citations). Therefore Ginter meets all the limitations of claim 4, namely:

..information to specify an intermediator of the issuance of the electronic license and an agreement for certifying that the intermediation of the issuance of the electronic license corresponding to the specified information for verification is allowed to the specified intermediator are input to the license generation means together with the information to specify information for verification; and

it is checked by the agreement whether or not the intermediation of the issuance of the electronic license corresponding to the information for verification is allowed to the intermediator and only in the case the intermediation is allowed, the electronic license is generated.

As per **claim 5**:

Ginter discloses all the limitations of claim 2.

Ginter further discloses that a "metering history" can be incorporated into any licensing of products to be distributed (see above citations; Col 20, line 42; Col 24, lines 24-53). Therefore Ginter discloses all the limitations of claim 5:

..further comprising: a license issuance history memory unit for storing an issuance history of an electronic license;

a content provider's issuance history preparing unit which receives information to specify a content provider of digital contents and extracts an issuance history which is a history of the issuance of a license for digital contents provided by the specified content provider from the issuance histories stored in the license issuance history memory unit; and

a content provider's issuance history output unit for outputting the issuance history for the specified content provider generated in the content provider's issuance history preparing unit.

As per **claim 6**:

Ginter discloses all the limitations of claim 2.

Ginter further discloses that a "metering history" can be incorporated into any licensing of products to be distributed (see above citations; Col 20, line 42; Col 24, lines 24-53). Therefore Ginter discloses all the limitations of claim 6:

...further comprising:

license request receiving means for receiving a request for issuance of an electronic license,

wherein, in the case the license request receiving means receives a

request for the issuance of an electronic license, an electronic license is generated in the license generation means, wherein the license-issuing system further comprises:

a license issuance history memory unit for storing an issuance history of an electronic license;

a requestor's issuance history preparing unit which receives information to specify a requester of the issuance of the license and extracts the specified requestor's issuance history, which is the issuance history of

the electronic license requested from the specified requester, from the issuance histories stored in the license issuance history memory unit; and a requestor's issuance history output unit for outputting the issuance history for the requester prepared in the requestor's issuance history preparing unit.

As per **claim 7**:

Ginter discloses all the limitations of claim 2.

Ginter further discloses that a "metering history" can be incorporated into any licensing of products to be distributed (see above citations; Col 20, line 42; Col 24, lines 24-53). Therefore Ginter discloses all the limitations of claim 7:

...further comprising:

a verification information issuance history memory unit for storing a history of issuance of information for verification;

a verification information issuance history preparing unit which receives information to specify a recipient of information for verification

and extracts the issuance history which is a history of the issuance of the information for verification issued to the specified recipient from the issuance histories stored in the verification information issuance history memory unit; and

a verification information issuance history output unit for outputting the issuance history prepared in the verification information issuance history preparing unit.

As per **claim 8**:

Ginter discloses all the limitations of claim 2.

Ginter further discloses that public/private key pairs will be used for encrypting/decrypting data packages transmitted through the network (see above citations). Therefore Ginter discloses all the limitations of claim 8:

> ...further comprising:
> public key pair preparing means for generating a public key pair; and
> private key storage means for storing a private key of the public key pair prepared in the public key pair preparing means, wherein:
> the information for verification is the public key prepared by the public key pair preparing means; and
> the license is generated using the private key stored in the private key storage means.

As per **claim 11**:
Ginter discloses all the limitations of claim 10.

Ginter further discloses that a public key of a public/private key encryption pair may be used to specifically encrypt each piece of content transmitted from one network participant to another (see above citations). Therefore Ginter meets all the limitations of claim 11:

> ...information for verification required to verify legitimacy of a specific license is bound with specific digital contents; and
> information to specify the information for verification is included in the first and second license requests.

As per **claim 12**:
Ginter discloses all the limitations of claim 10.

Ginter further discloses that fine-grained control of usage conditions for content is possible with his system (see above citations). Therefore Ginter meets all the limitations of claim 12:

> ...the requested license includes a usage condition which is a condition for limiting the usage of digital contents;
> usage condition preparing means for preparing the usage condition to be included in the requested license is provided; and
> the usage condition prepared by the usage condition generation means is included in the second license request prepared by the license request preparing means.

As per **claim 13**:
Ginter discloses all the limitations of claim 10.

Ginter further discloses that negotiations, contracts, and agreements governing licensing, distribution, and use of content are all possible with his system, incorporated into the data "objects" transmitted among participants of his "chain of handling and control" (see above citations). Therefore Ginter meets all the limitations of claim 13:

> ..agreement storage means for storing an agreement for certifying that the system is permitted to intermediate the issuance of a license for specific digital contents, wherein
> the agreement stored in the agreement storage means is attached to the license request prepared by license request preparing means.

As per **claim 14**:
Ginter discloses all the limitations of claim 10.

Ginter further discloses that budgeting and billing methods are easily implemented with his system (see above citations). Therefore Ginter meets all the limitations of claim 14:

...accounting means for charging a license issuance fee to a requester of the first license request, wherein:
when the first license request is received, the license issuance fee is charged to the requester by the accounting means.

As per **claim 15**:
Ginter discloses all the limitations of claim 10.
Ginter further discloses that payment and collection methods are easily implemented within his Virtual Distribution System (see above citations). Therefore Ginter meets all the limitations of claim 15:

...settlement means for collecting a license issuance fee from a requester of the first license request, wherein:
when the first license request is received, the license issuance fee is collected from the requester by the settlement means.

As per **claim 18**:
Ginter discloses all the limitations of claim 17.
Ginter further discloses that fine-grained control of usage conditions for content is possible with his system (see above citations). Therefore Ginter meets all the limitations of claim 18:

..usage condition limitation information generating means for generating usage condition limitation information which limits a range of a usage condition for limiting the usage of digital contents, wherein:
the usage condition limitation information generated by the usage condition limitation information generating means is included in the agreement generated by the agreement generating means.

As per **claim 19**:
Ginter discloses all the limitations of claim 17.
Ginter further discloses that a "metering history" can be incorporated into any licensing agreement of products to be distributed (see above citations; Col 20, line 42; Col 24, lines 24-53). Therefore Ginter meets all the limitations of claim 19:

..an agreement issuance history memory unit for storing an issuance history of an agreement;
a history preparing unit which receives information to specify an intermediator and extracts an issuance history for the agreement issued to the specified intermediator from the issuance histories stored in the agreement issuance history memory unit; and
a history output unit for outputting the issuance history prepared in the history preparing unit.

As per **claims 26, 28, 30**:
Ginter discloses all the limitations of claims 25, 27, 29 respectively. Ginter further discloses that the content and rules governing the access and use of said content may be extracted (Cols 189 – 206: "Examples of VDE Methods"). Therefore Ginter discloses all the limitations of claims 26, 28, 30, namely:

..the information for verification is included in digital contents; and the information for verification is extracted from the digital contents and is stored in the verification information storage means.

As per **claims 31-34**:
Ginter discloses all the limitations of claims 24, 25, 27, 29 respectively.
Ginter further discloses a portable memory unit that can perform all the functions describes by claims 31-34 (see above citations; Col 254-262, "Portable Electronic Appliance"). Therefore Ginter meets all the limitations of claims 31-34, namely:

..further comprising: connection means for connecting to the system a portable memory unit that stores an electronic license, wherein:
the license verification means verifies the legitimacy of the electronic license stored in the portable memory unit connected via the connection means.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Le whose telephone number is 703-305-4567. The examiner can normally be reached on 8:30am-5:30pm Mo-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

DQL
December 15, 2002

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